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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,820	02/25/2005	Kai Fabian	MERCK-2979	9173
23599 7590 08/28/2008 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER YOUNG, SHAWQUA				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
08/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/525,820

**Applicant(s)**

FABIAN ET AL.

**Examiner**

SHAWQUIA YOUNG

**Art Unit**

1626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) 2-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1, 12, 13 and 15-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-13 and 15-19 are currently pending in the instant application. Applicants have cancelled claim 5 and added new claims 11-13 in an amendment filed on July 12, 2007.

#### **I. *Response to Arguments***

Applicant's amendment, filed May 16, 2008 has overcome the rejection of claims 1, 12, 13 and 15-19 under 35 USC 112, first paragraph for scope of enablement. The above rejection has been withdrawn.

As mentioned in the beginning of prosecution in the Office Action mailed on December 29, 2006 that once the claims were free of art then the Examiner will extend the search of the Markush-type claim. However, the Examiner will not extend the search on the genus as a whole because the instant claims require different search considerations (i.e., class/subclass searches, databases searches, etc.). The inventions are classified into classes 514, 540, 544, 546, 548, 549, etc. However, each Class 514, 540, 544, 546, 548, 549, etc. encompasses numerous patents and published applications. For instance, Class 514 contained 165,171 patents and published applications. Therefore it would constitute a burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety. The Examiner has attempted to search the genus structure where R1 is an aromatic heterocyclic group but the search could not be completed because the genus structure embraces vast subject matter. Therefore the Examiner has extended the search to include wherein R1 is

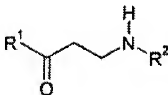
thienyl or furyl. Applicants are required to delete the non-elected subject matter that is not embraced by compounds wherein R1 is thienyl or furyl.

## B. Status of the Claims

### i. Scope of the Elected Subject Matter

The scope of the subject matter is the compounds of formula (I) in claims

1, 12, 13 and 15-19 wherein:



$R^1$  is thienyl, which is unsubstituted or mono- or polysubstituted by  $R^3$  and/or  $R^4$ ;

$R^2$  is  $C_1$ - $C_{20}$  alkyl;

$R^3$ ,  $R_4$  are independently H, alkyl, or  $C_1$ - $C_{20}$  alkoxy, aryl, aryloxy or  $COOR^2$ , F, Cl, Br, OH, CN,  $NO_2$ ,  $N(R^2)_2$  or  $NHCOR_2$ ;

### ii. Extended Prior Art Search M.P.E.P. §803.02

If upon examination of the elected species, no prior art is found that would anticipate or render obvious the instant invention based on the

elected species, the search of the Markush-type claim will be extended. See M.P.E.P. § 803.02 (2001). If prior art is then found that anticipates or renders obvious the non-elected species, the Markush-type claim will be rejected. It should be noted that the prior art search will not be extended unnecessarily to cover all non-elected species. Should Applicant overcome the rejection by amending the claim, the amended claim will be reexamined. Id. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. Id. In the event prior art is found during reexamination that renders obvious or anticipates the amended Markush-type claim, the claim will be rejected and the action made final. Id.

As indicated above, Examiner searched the compound based on the elected species, above, in response to the requirement to restrict the products of Formula (I), wherein: there was not prior art of record that anticipated or rendered obvious the elected species and therefore the scope of the subject matter was **extended or broadened** in pursuant to M.P.E.P. § 803.02.

The prior art search was extended to include the products of formula (I) wherein:

**R<sup>1</sup>** is furyl, which is unsubstituted or mono- or polysubstituted by **R<sup>3</sup>** and/or **R<sup>4</sup>**.

iii. Non-elected Subject Matter Withdrawn 37 C.F.R. §1.142(b)

The non-elected subject matter withdrawn are the compounds of formula (I), claims 1, 12, 13 and 15-19 (in-part) wherein:

$R^1$  is as defined in claim 1 excluding thienyl and furyl, which is unsubstituted or mono- or polysubstituted by  $R^3$  and/or  $R^4$ .

II. **Objections**

Claim Objection-Non Elected Subject Matter

Claims 1, 12, 13 and 15-19 are objected to as containing non-elected subject matter. To overcome this objection, Applicant should submit an amendment deleting the non-elected subject matter.

III. **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./

Primary Examiner, Art Unit 1626